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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,738	02/24/2000	HongHai Shen	ST9-99-151	5283

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MADSON & METCALF
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101

EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 07/30/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary

Application No.

09/512,738

Applicant(s)

SHEN ET AL.

Examiner

Joshua D Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 24, 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent. The non-patent document "Dynamic Parameter Setting for CICS" has not been considered since a copy of the reference was not provided.

Specification

2. The disclosure is objected to because of the following informalities:

The word "handing" on page 4, line 9, should be changed to "handling".

The word "an" on page 7, line 6, should be changed to "a".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 8, 10-12, 18, 20-22, 28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Boehme (US Patent Number 6,578,192, filed on October 20, 1999).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

4. **Regarding independent claims 1, 11, and 21, Boehme discloses a method that can be implemented on HTML documents by a web server (column 5, lines 10 and 11 of Boehme), in which a requested HTML document is passed to a parser to be rendered in a DOM tree representation (column 5, lines 34-36 of Boehme). The objects in this DOM tree are sent to an interpreter, where they are processed according to the script commands and replaced by a return object (column 5, lines 39-47 of Boehme). Once all elements in the DOM tree have been processed it is then passed to a serializer**

Art Unit: 2178

which will generate a linear version of the tree in the form of an HTML representation (column 5, lines 55-58 of Boehme).

5. **Regarding dependent claims 2, 12, and 22**, Boehme discloses the method of passing script commands to an interpreter to control the processing of objects (column 5, lines 39-48 of Boehme).

6. **Regarding dependent claims 8, 18, and 28**, Boehme discloses the method of returning the document to the client once it has been fully processed (column 6, lines 63-65).

7. **Regarding dependent claims 10, 20, and 30**, Boehme discloses the method of replacing a node in the DOM tree with another suitable node once if the processing requires it (column 5, lines 50-54 of Boehme).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 3-7, 9, 13-17, 19, 23-27, and 29 are rejected under 35 U.S.C. 103(a) as being obvious over Boehme (US Patent Number 6,578,192, filed on October 20, 1999) in view of Chadha (US Patent Number 6,061,698, filed on October 22, 1997).**

The applied references have a common assignee and the secondary reference has one common inventor with the instant application. Based upon the

earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

10. Regarding dependent claims 3, 13, and 23, Boehme discloses a method of receiving a request for a document from a client. Boehme does not teach identifying the script file within the document server that goes with the requested document. However, Chadha discloses a method of merging tagged documents and scripts in which a request is made for a tagged document. When this request is made the document is

Art Unit: 2178

identified and based on this identification the predefined script file is selected (column 3, lines 53-57 of Chadha). One of ordinary skill in the art at the time the invention was made would have used the technique of selecting the proper corresponding script file as disclosed by Chadha in the method of processing dynamic documents disclosed by Boehme. It would have been obvious to one of ordinary skill in the art since it would have allowed the client to only select one of the two files to be operated on and gain access to both.

11. **Regarding dependent claims 4, 14, and 24**, Boehme discloses the use of his method for web pages (column 3, lines 61-65 of Boehme). Boehme does not disclose the specific type of client program that would be used to make requests to the server that would produce the dynamic web pages. However, one of ordinary skill in the art would have known that a web browser is the most commonly used program to make requests to view a web page. One skilled in the art at the time the invention was made would have used a web browser as the client program for the method disclosed by Boehme. It would have been obvious to one of ordinary skill in the art because it would have employed common practice without changing the method disclosed.

12. **Regarding dependent claims 5, 15, and 25**, neither Boehme nor Chadha disclose a method in which the script file is requested and the corresponding document is found. However, Chadha does disclose a method of finding a script file once a document is requested (column 3, lines 53-57 of Chadha). One of ordinary skill in the art would have known that the order in which the files are requested and found is arbitrary to the functionality of the method. One of ordinary skill in the art at the time the

invention was made would have used the method of Chadha as shown above (column 3, lines 53-57 of Chadha) to carry out a request by the client for a script file by identifying the script file and selecting the proper corresponding tagged document. It would have been obvious to one of ordinary skill in the art because the order in which the files are requested and selected does not affect the functionality of the Chadha's method.

13. **Regarding dependent claims 6, 16, and 26**, Boehme discloses the use of a file containing both the tagged document and the script file (column 5, lines 63-67 of Boehme). Boehme does not disclose containing these two documents in separate portions. However, one of ordinary skill in the art would have known that separating the two documents into separate portions of the file is a method of housekeeping, doing this does not change the functionality of Boehme's method. One of ordinary skill in the art at the time the invention was made would have used the method of separating the documents into separate portions of the embedded file disclosed by Boehme. It would have been obvious to one of ordinary skill in the art because it would have made it easier to maintain and update the dynamic document.

14. **Regarding dependent claims 7, 17, and 27**, Boehme does not disclose a method having the script and document files being logically separate. However, Chadha discloses a method of merging tagged documents and script files in which the files are not contained in one file (column 3, lines 53-57 of Chadha). One of ordinary skill in the art at the time of the invention would have used the method of separating the document and script files as disclosed by Chadha in the method of processing dynamic

Art Unit: 2178

documents as disclosed by Boehme. It would have been obvious to one of ordinary skill in the art because it would have allowed the script and document files to be maintained and updated separately.

15. **Regarding dependent claims 9, 19, and 29**, Boehme does not disclose a method of replacing objects in a DOM representation with database values. However, Boehme discusses one possible use of dynamic web pages to display information from a database (column 1, lines 40-42 of Boehme). The method disclosed by Boehme is simply a method of processing dynamic web pages, thus there are no boundaries existing that would disallow the ability to display information from a database. One of ordinary skill in the art would have used the method of Boehme on dynamic web pages that display results from a database. It would have been obvious to one of ordinary skill in the art because it would have been inherent in the method of Boehme to properly process these dynamic web pages.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Number 6,151,623, filed on December 13, 1996, by Harrison et al.

US Patent Number 6,519,617, filed on April 8, 1999, by Wanderski et al.

US Patent Number 5,835,712, issued on November 10, 1998, by DuFresne

(cited by applicant).


Art Unit: 2178

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

jdc
July 23, 2003


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100